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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION N |
|---|-------------|----------------------|---------------------|----------------|
| 10/052,688 | 01/18/2002 | Denise R. Barbut | 270/236 | 4085 |
| 34263 | 7590 | 10/05/2004 | EXAMINER | |
| O'MELVENY & MEYERS 114 PACIFICA, SUITE 100 IRVINE, CA 92618 | | | THOMPSON, MICHAEL M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3763 | |

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/052,688 | BARBUT ET AL. |
| | Examiner Michael M. Thompson | Art Unit 3763 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 7-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 July 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 07/02/2004. These drawings are acceptable.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims ~~1-7~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Milder et al. (5,116,305) in view of Fisch (6,468,200). Milder et al. teaches all of the limitations of the claims except for a sausage shaped balloon and a balloon length of approximately 3-6 cm. Fisch teaches a sausage shaped balloon. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the balloon structure of Milder et al. as a sausage shaped balloon as taught by Fisch as taught in the art of intra-aortic balloons for optimal fit within the aorta. Furthermore, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to reduce the balloon length to approximately 6 cm or 3-6 cm because Applicant has not disclosed that a balloon length of 3-6 cm provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's

invention to perform equally well with a length of 7-10 cm balloon because both a balloon length of 3-6 cm or 7-8 cm perform the same function of preventing flow within the aorta depending mostly on inflation and the size of the subject. Please note that a change in shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

4. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milder et al. in view of Manning (5,216,032) or Paradis (5,334,142). Milder et al. teaches all of the limitations of the claims except for a method of cerebral perfusion by occlusion of the aorta and a balloon length of approximately 3-6 cm. Both Manning and Paradis teach methods of occluding the aorta for the purpose of cerebral perfusion. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have utilized the device as taught by Milder et al. as a balloon device as taught by Manning or Paradis for the purpose of at least partially occluding the aorta and thereby achieving cerebral perfusion. Furthermore, it is obvious if not inherent that both Manning and Paradis teach measuring the pressure and adjusting the balloon to achieve the optimal cerebral perfusion specific to each patient. Both Manning and Paradis clearly attempt to achieve perfusion of the cerebral vasculature. Lastly, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to reduce the balloon length to approximately 6 cm or 3-6 cm because Applicant has not disclosed that a balloon length of 3-6 cm provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a length of 7-10 cm balloon because both a

balloon length of 3-6 cm or 7-8 cm perform the same function of preventing flow within the aorta depending mostly on inflation and the size of the subject.

Response to Arguments

5. Applicant's arguments with respect to claims 1-5 and 7-11 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The Examiner can normally be reached on Monday through Friday from 9 am to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Nick Lucchesi, can be reached on (703) 308-2698. The official fax phone number for all submissions to the organization where this application or proceeding is assigned is (703) 872-9306.

Michael M. Thompson

Patent Examiner

MT



LOAN H. THANH
PRIMARY EXAMINER

October 1, 2004